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Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
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AUG 22 2001

RJH
Paper No. 16

In re Application of:
TESSIER-LAVIGNE ET AL.
Serial No.: 09/273,098
Filed: March 19, 1999
For: Composition for Promoting Nerve Regeneration

DECISION ON PETITION

This is a decision on the petition, filed May 25, 2001, either to charge applicants' deposit account for a further extension of time or revive the application. The petition is being considered here as a request for reconsideration before the Director of TC1600.

On May 2, 2000, a non-final Office action was mailed to applicants that set a three month shortened statutory period for response thereto. On September 12, 2000, applicants filed a response to the May 2, 2000 Office action wherein the response included a petition for any necessary extension of time pursuant to 37 CFR 1.136(a). The response also included a certificate of mailing dated September 5, 2000. Based on the September 5, 2000 certificate of mailing date, applicants' deposit account was charged for a one month extension of time. (A one month extension of time extended the period for response up to and including September 5, 2000 because September 2, 2000 fell on a Saturday. September 5, 2000 was the next business day because September 4, 2000 was a Federal Holiday, Labor Day. September 12, 2000 was the date the response was actually received in the Office.) Prosecution continued based on this analysis. However, on February 8, 2001, applicants filed a letter that said "that our prior Response bearing a certificate of mailing date of Sept 5, 2000, was probably not actually deposited with the US Postal Service until the next day, Sept 6, 2000." From this, applicants concluded that an additional one month extension of time was needed to render the September 12, 2000 paper timely and requested that applicants' deposit account be charged accordingly.

On or about May 25, 2001, Robert Hill, Quality Assurance Specialist of TC1600, informed applicants' attorney, Mr. Richard Osman, in a telephone conversation that the Office would not charge applicants' deposit account for the requested additional one month extension of time. Two reasons were given by Mr. Hill. The first was that unless there was a more definitive statement than the paper was "probably" actually mailed on September 6, 2000, the Office would still consider the paper as having been mailed on September 5, 2000. The second was that if a more definitive statement was provided, the application would be considered abandoned for failure to timely file a response to the May 2, 2000 Office action. This prompted the petition filed on May 25, 2001.

Art Unit: 1600

Petitioner did provide a more definitive statement that the September 12, 2000 response was actually placed in the mail on September 6, 2000, not September 5, 2000 as set forth in the certificate of mailing. However, it is petitioner's position that because the response included a petition for *any necessary extension of time pursuant to 37 CFR 1.136(a)* and the Office retroactively charges other fees when an error in payment is brought to the attention of the Office, such as small entity fees, the Office should merely charge applicants' deposit account for the additional one month extension of time and consider the application as still pending.

37 CFR 1.136(a)(3) says:

A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporation a petition for extension of time for the appropriate length of time.

This does allow applicants to include a petition for *any necessary extension of time pursuant to 37 CFR 1.136(a)* as set forth in the September 12, 2000 response. However, 37 CFR 1.136(a)(2) says:

The date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee.

Thus, while a petition for *any necessary extension of time pursuant to 37 CFR 1.136(a)* might seem to be somewhat open ended, it really is a request for an extension for a specific period of time, i.e., the minimum period of time in whole months needed to render the paper timely as of the filing date of the paper (without exceeding the maximum time period set by statute, of course). How, then, does the Office determine the filing date of a paper or extension? When the paper is filed using the provisions of 37 CFR 1.8, certificate of mailing procedure, the filing date of the paper is the date that the certificate says that the paper was placed in the mail. In this case, that date was September 5, 2000. In other words, in accordance with 37 CFR 1.136(a), a paper with a certificate of mailing dated September 5, 2000 and a petition for *any necessary extension of time pursuant to 37 CFR 1.136(a)* is properly construed by the Office as a petition for an extension of the minimum period of time in whole months needed to render the paper timely as of September 5, 2000. In this case, the minimum period of time in whole months was one month. That is why the Office charged applicants' deposit account for a one month extension of time. Since petitioner admits that the paper was not placed in the mail until September 6, 2001, the paper was untimely relative to the request for extension of time.

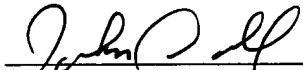
Furthermore, based on the above quote from 37 CFR 1.136(a)(2), the only way for the Office to properly construe the February 8, 2001 or May 25, 2001 requests to charge an additional period of extension to render the September 12, 2000 paper timely is that they are petitions for extensions of time filed on their respective dates. Consequently, those dates are the appropriate ones for determining the period of extension requested in those papers. Since the dates of those papers are subsequent to the maximum time period set by statute for responding to the May 2,

Art Unit: 1600

2000 Office action, those papers cannot be properly construed as extensions of time under 37 CFR 1.136.

In summary, since 1) petitioner admits that the September 12, 2000 response was actually mailed on September 6, 2000, not September 5, 2000, 2) the petition for extension of time in that paper was not sufficient to render the paper timely for the reasons set forth above, and 3) the subsequent requests for extension filed on February 8, 2001 and May 25, 2001 were not sufficient for the reasons set forth above, it is reasonable to conclude that the September 12, 2000 response was untimely. **Accordingly, the application is hereby abandoned for failure to timely file a response to the May 2, 2000 Office action and the request of May 25, 2001 is hereby denied. The application has been forwarded to the Office of Petitions to treat the May 25, 2001 paper as a petition.**

REQUEST DENIED.



John Doll, Director
Technology Center 1600

RICHARD ARON OSMAN
SCIENCE & TECHNOLOGY LAW GROUP
75 DENISE DR
HILLSBOROUGH, CA 94010